Supreme Court of the United States

OCTOBER TERM, 1903.

JAMES McLOUGHLIN,
Plaintiff-in-Error,

vs.

THE RAPHAEL TUCK & SONS COMPANY, LIMITED,
Defendant-in-Error.

IN ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR PLAINTIFF-IN-ERROR

A. BELL MALCOMSON,
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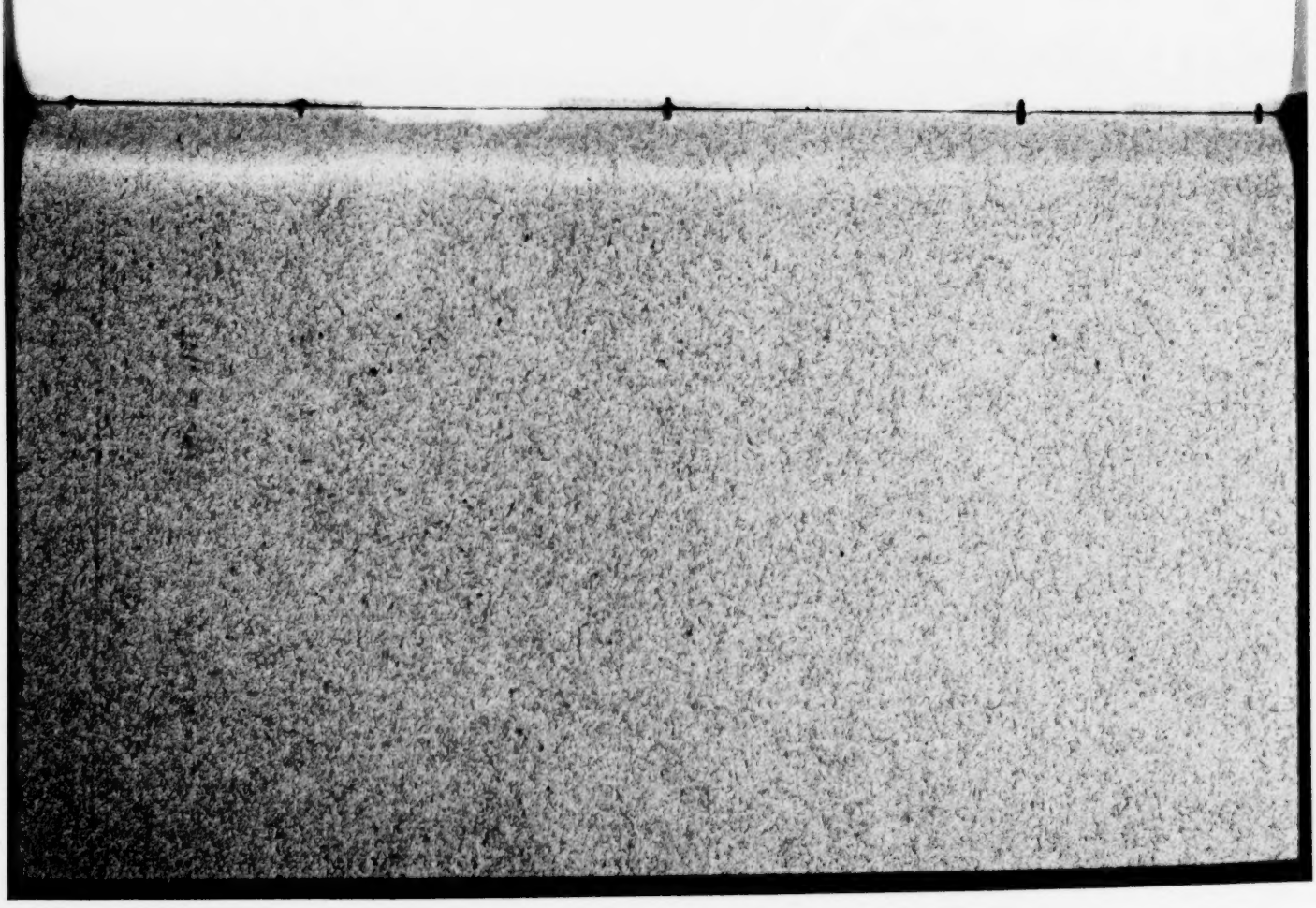
APPEAL PRINTING CO., 14 Vesey St. TEL. 192 CORTLANDT.



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Brief for Plaintiff-in-Error.

Statement.

This is an action for violation of the copyright law.

The provisions claimed to have been violated are contained in Section 4963 of the Revised Statutes.

The defendant is a publisher of books and calendars, consisting largely of highly colored chromolithographs. It is a New York corporation doing business in the City of New York, and all books, made for it, are specially prepared for publication and sale in the markets of this country.

Complaint.

The first seventy causes of action, set forth by the complaint, are that defendant published, in August, 1896, at the City of New York, and knowingly *inserted and impressed* a false notice of copyright, on seventy different books, described by names and numbers.

The remaining causes of action are for knowingly issuing and selling at the City of New York certain specified books with a false copyright mark on them in 1897.

The first seventy causes of action are based on the act of "*inserting or impressing*" the false notice in violation of Section 4963, as it read before the amendment of March 3, 1897.

The remaining causes of action are for the act of *selling* books falsely marked, such act being made a violation of the same section by the amended act of March 3, 1897.

Answer.

The answer, 1st, Admits that the defendant is a corporation formed under the laws of the State of New York, carrying on business in the City of New York (Par. II).

2nd. Admits the publication and sale in 1896 of the books complained of in the first 70 causes of action (Par. III).

3rd. Admits that the books bore a notice that they had been copyrighed by defendant and that they were proper subjects of copyright (Par. IV).

4th. Admits that the defendant had not obtained a copyright on the books and that such notice on them was false (Par. IV).

5th. Denies that defendant inserted or impressed the false notice of copyright of the books by defendant (Par. III).

Defendant's Admissions.

On the trial the defendant made the following admissions in open Court:

1st. Defendant admitted that the books were sold and published by defendant at the times alleged in the complaint, with the statement of copyright thereon (page 15, manuscript R).

2nd. That the printed statement on the books that a copyright issue had been obtained by defendant was false (p. 15).

3rd. That such false notice of copyright was inserted and impressed upon the books under the authority of the defendant (p. 15).

The plaintiff by request of the Court admitted that the books enumerated in the first seventy causes of action came from abroad in 1896 (p. 15).

It is self evident fact that the goods must have been brought into the country prior to 1897 if they were sold here in 1896.

These books are the one alleged in the complaint to have been issued and published in New York in 1896 and to have had the false notice o copyright impressed on them by defendant.

As to the books complained of in the seventy-first to the eighty-third cause of action, the defendant admitted:

1st. That all of said books were sold by defend. ant and had the false statement of copyright printed on them.

2nd. That such false notice that a copyright thereon had been ontained by defendant was inserted and impressed on the books by authority of defendant.

3rd. That the books numbered 1750 and 1754 were sold in June, 1897 (fol. 78) and the books

numbered 1738, 1739, 1740, 1741, 1742, 1748, 1749, 1750, 1751, 1752, were sold on or about the 26th of April, 1897 (fol. 80).

The Court then stated to defendant in relation to "these later books":

"Court: It put you to the proof to show affirmatively that they got in here before March 3, 1897."

Under this ruling the defendant was required to prove affirmatively that these books referred to in the later causes of action came under the proviso of the Amended Statute. The admissions covered all other points.

The only witness examined by defendant for this purpose was Samuel Gabriel, the secretary and treasurer of the defendant.

This witness testified:

1st. That book, No. 1742 (one of the books previously admitted to have been sold with the false notice impressed on it), was imported in May, 1897 (p. 18).

2nd. That he could not swear of his own personal knowledge that the other books were not brought into this country in 1897.

Defendant then attempted to prove also by this witness a contradiction of the admission that the books, including 1742, bore the false statement of copyright at time of sale.

Plaintiff moved to strike out such testimony as not pertinent and his motion was denied (p. 19).

On this case being presented the Court directed a verdict in favor of defendant, with all exceptions to plaintiff (p. 23).

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POINTS.

I.

The plaintiff was entitled to judgment on the first seventy causes of action, and the plaintiff's exception to the direction of a verdict should have been sustained.

As to the first seventy causes of action the complaint alleges that the defendant at the City of New York in the State of New York, on August 1, 1896, issued certain books "and in and upon said book did knowingly insert and impress a false and fictitious notice that the same was copyrighted, which notice was in the following words: 'Copyright 1896, by Raphael Tuck & Sons, Ltd.'" (Par. III of complaint).

This pleading was held to be a good allegation that the insertion of the notice was done at the City of New York.

The defendant demurred to this same language in another case and the Court held:

> "The obvious meaning of the allegations is that the publication and insertion of the notice was at the City of New York."

Rigney vs. Tuck, 77 Fed. R., 173.

The admission of defendant on the trial was full and complete as to the facts alleged in the complaint of inserting and impressing in 1896 (p. 15-16).

The admission of plaintiff that those seventy books were brought into the country in 1896 in no way affected the act of inserting and impressing of the false notice by the defendant at New York in August, 1896.

The law was in no way changed by the amendment of 1897 so as to affect these seventy causes of action.

The offense constituting the first seventy causes of action was the "inserting" in or "impressing" on the books a false statement of copyright.

Section 4963 remains as it originally stood in relation to the inserting or impressing of a false notice of copyright.

There was no repeal of the former statute by the amendment of 1897. The concluding clause of the amendatory act states:

> "That all laws and parts of laws inconsistent with the foregoing provision be and the same are hereby repealed."

The provisions in relation to impressing of a false notice are not inconsistent with, but are a part of the section as amended.

> "The doctrine that a statute is impliedly repealed by a subsequent statute revising the whole matter of the first, does not apply where the revisory statute declares what effect it is intended to have upon the former; as where it provides that such provisions of the earlier as are inconsistent with the latter act, are repealed. In such cases only such effect can be given to the revisory act, as it directs; only the provisions inconsistent are repealed."

Patterson vs. *Tatum*, *3 Sawyer*, *164*.

The publication of the books by defendant at the City of New York, with the false statement that they were copyrighted by defendant *printed on them, by the authority of* DEFENDANT, was the offense of inserting or impressing covered by the statute.

When interpreting this section of the statute, before amendment, in the case of Rosenbach vs. Dreyfuss, 2 Fed. R., 220, the Court said:

> "The offence is deceiving the public by the false assertion of a valuable privilege to which a party is not entitled."
>
> * * * * * *
>
> "The purpose of the statute seems to be to protect persons entitled to copyright from their privilege being impaired, cheapened and lessened in value by *the unauthorized assumption* of the privilege by persons not entitled thereto."

It was at the City of New York, where the books were issued and sold, that the offense and violation of the statute was committed.

Section 4962 requires a proprietor, as a prerequisite to an action for the infringement of a copyright, to "give notice thereof by inserting in the several copies of every edition *published* * * * the statement that the book is copyrighted."

The following Section, 4963, provides as follows:

> "Every person who shall insert or impress *such* notice, or words of the same purport, in or upon any book," etc., "shall be liable to a penalty."

It was said by the Circuit Court of Appeals in this circuit:

> "The statutes refer to a published edition, which is an edition offered to the public for sale or circulation."
>
> *Falk vs. Gast. Litho. & Eng. Co., 54 Fed. R., 890.*

It matters not where the mere act of printing is done. The books might be printed with the false statement of copyright on them and still there would be no violation of the statutes unless there was an "issuance coupled with a sale."

If the books containing the statement of copyright should not be published, of course there woould be n "*notice*" within the meaning of the statute. The mere printing would be of no avail and the public would not be deceived.

The distinct statement of the statute (Sec. 4963) that it applies to "*such notice*," referring back to Section 4962 has always been construed to mean more than the mere act of printing.

Where the issuing and sale by the party authorizing the printing on the book of the false statement that it is copyrighted by such person takes place, there the violation of the statute takes place. Even if it be contended that the admissions do not specifically cover the point, the defendant cannot avoid liability under the statute by claiming that the means for violating the law (the mere act of printing the words on the book), were prepared and done under his authority at some other place than New York.

A long line of decisions has established the law that it is at the place where the consummation of the wrongful act takes place that the statutes are violated.

The People vs. Rathburn, 21 Wend., 533.
The People vs. Adams, 1 N. Y., 175.
U. S. vs. Davis, 2 Summ., 485.
Tyler vs. People, 8 Mich., 326.
Secs. 730-2, U. S. Rev. Statutes.

A libel uttered in one country and published in another country is triable in the country where the libel is published.

Commonwealth vs. Blanding, 3 Pick., 394.

II.

The proviso in the amending statute has no relation to the "inserting or impressing" of a false notice of copyright.

Prior to the amendment a practice had grown up among foreign publishers of placing on books, designed for sale in this country, a false statement that there was a copyright by some unknown or fictitious person, on such books, by printing thereon the words prescribed by our statute to give notice of copyright The printed notice did not in any way refer by name to the party who put them on the market here, nor was the printing authorized by the importer.

The case of Rigney vs. Dutton, 77 Fed. R., p. 176, is an instance.

There the books were marked "Copyrighted by E. Nister" but imported and sold by Dutton. Under the statute before amendment Dutton could legally import and sell the books with the Nister claim of copyright, as he had no connection with the printing of the books.

The proviso of the amendment is in relation to the importation of, or sale of, such articles, bear- a false notice of copyright by some unknown or fictitious person, and was not required for cases where the *name of the publisher here* is contained in the false claim of copyright; or cases where the claim of copyright was printed on the book by authority of the person selling it here. Such act was illegal under the statute before amendment.

The language of the proviso is as follows:

> "Provided, That this act shall not apply to "any IMPORTATION OF, or SALE OF such "goods or articles brought into the United "States prior to the passage hereof."

The *importation of*, and *sale of*, falsely marked goods were the things against which the new parts of the Amending Act were directed. And a right to summarily enjoin the sale of such importations was given by the amendment. There is nothing in the proviso which states or implies that the act should not apply to violations of the statute before amendment by reason of "inserting or impressing" a false notice of copyright.

The violation of the statute admitted by defendant in this case is "impressing" a false notice on the books, *not the act of importing or selling a falsely marked book*.

It will be seen that the proviso is designed to, and would, protect such parties as Dutton, who might have imported, prior to the passage of the amendment, books containing a false claim that the books were copyrighted by "E. Nister" or other person with whom Dutton had no connection—and which statement of copyright Dutton had not authorized.

III.

Should it be held that by any implication the amendment repealed the old law, yet the plaintiff was entitled to judgment on the first seventy causes of action, which are for a liability incurred under the statute before amendment.

The statutes of the United States specifically provide that where a statute is repealed the liability for penalties is not released.

Reference to Section 13 of the Revised Statutes of the United States shows this to be the law.

"SEC. 13. The repeal of any statute shall not have the effect to release or extinguish any pen-

alty, forfeiture, or liability incurred under such statute, unless the repealing act shall so expressly provide, and such statute shall be treated as still remaining in force for the purpose of sustaining any proper action or prosecution for the enforcement of such penalty, forfeiture or liability."

There can be no valid pretense that liability for offenses already incurred under the statute for *inserting or impressing* is released by any *express provision* of the amendment of 1897.

"General saving statutes providing that the repeal of a statute shall not have the effect to release or extinguish any penalty, forfeiture or liability incurred thereunder are by law imported into the subsequent repealing acts, and obviate the necessity for individual saving clauses to save offenses committed before the repeal."

State vs. Hardman, 16 Ind. App., 357.

In relation to the first seventy causes of action arising in 1896 the case must be considered as if the amendment of 1897 had never been passed.

IV.

The Court erred in receiving testimony from defendant that the book 1742 did not have the false notice of copyright on it, and in refusing to strike it out and disregard it.

The defendant had admitted that all the books, including 1742, had a false notice of copyright impressed on them by defendant.

The defendant then attempted to prove that the book 1742 did not have the copyright mark on it. And the Court refused to strike such testimony out, to which plaintiff excepted.

"Any agreement deliberately made, any plain assent, express or implied, in respect to the orderly conduct of a suit, or even an agreement to admit a material fact upon the trial, cannot be revoked at the pleasure of the party."

"The Courts specifically enforce agreements made in respect to the course of the cause by persons properly authorized."

The People vs. Rathbone, 21 Wend., 543.

At the time of the trial of this case the defendant below had been driven from point to point in devising means to avoid responsibility for its frequent violations of the Copyright Law.

This is shown by the Rigney case where a demurrer was interposed.

Rigney vs. Tuck, 77 Fed. R., 173.

And by the Ross case; in the record of which it appears the witness Gabriel testified that defendant purchased the books in the open market and did not know anything about the marking or manufacture of them. Gabriel was substantially the only witness in the Ross case.

See opinion Cir. Ct. App.

Wallace, C. J.:

"There was no evidence tending to show "that the defendant had caused the insertion "of the fictitious copyright notice in the "books or knew that it was to be or had been "inserted previous to receiving the books."

Ross vs. Tuck, 33 C. C. A., 405.
Same case, 62 U. S. App., 317.

This Ross case is the one referred to in defendant's answer.

And by the Hortel case, which was another and later case and discloses a new device of defendant to evade the provisions of the law against false marking.

It is a case arising some time after the amendment of 1897 and this defendant is found still falsely marking books "copyrighted," and violating at least the spirit of the law, by using the copyright notice and leaving out the date so as to thereby avoid liability for the false marking.

The Court said in the Hortel case:

> "The records of this Court indicate that defendant is a persistent offender against the spirit of the Copyright Acts, but in this case it seems to have succeeded in escaping the express language defining the offense charged" (*Hortel vs. Tuck, 94 Fed. R., 844*).

In the present case, when brought to trial the defendant devised the specious course of admitting the inserting and impressing, which shut out all the testimony collected by plaintiff since the Ross case, going to show that instead of defendant having bought the goods in the open market, they were made for defendant under the personal direction of its officer Gabriel, for sale in the New York market and nowhere else.

Then having admitted on the trial that the books all bore the false mark he was allowed to contradict that fact as to the book 1742.

The admission was that the books all bore the false mark and that such mark was impressed by authority of defendant on them at time of publication.

The Court: You admit the sale and admit false notice?

Mr. Raegener: Yes, sir.

The witness of defendant is then asked:

"Q. Then the book referred to as 1742, and which is referred to in the 77th Cause of Action, and which it is alleged the defendant sold on or about April 26, 1897, did not have the copyright notice on?

A. It certainly did not."

This was an attempt to contradict the admissions already made by defendant. The plaintiff promptly moved to strike it out.

"Mr. Malcomson: I move to strike that testimony out as not being relevant."

* * * * * *

"The Court: Motion denied; exception."

Because the witness was expert in getting his answer in before he could be stopped, the plaintiff should not be prejudiced.

The testimony should be disregarded in view of the admissions already entered of record

Th admission should prevail over the attempt to contradict it.

Otherwise, the plaintiff would be prejudiced by the very act of admission by defendant.

Plaintiff's counsel did not avail himself of the Court's suggestion at the trial to cross-examine this interested hostile witness, on this point, of whether or not the book already admitted to have been falsely marked was in fact so marked.

When the admission was made that the book bore the false notice when sold, it is fair to presume that all plaintiff's witnesses and means for proving that fact were dismissed.

The admission was made for the purpose of having plaintiff forego all proof on that point.

Even in criminal cases proper admissions made at the trial cannot be retracted, or gainsaid by the party making them.

The People vs. Rathburn, *supra*.

V.

There was no reliable proof that the books mentioned in the 71st to the 83d causes of action were brought into the country prior to the passage of the amendment.

The defendant was required to prove affirmatively the fact that would bring the books within the proviso.

The Court: "It puts you to the proof to show affirmatively that they got in here before March 3, 1897."

The only proof offered was that of the witness Gabriel.

He makes general statements that the books (except 1742) must have been imported in 1896.

His testimony is found at p 17. Trans. of Record:

"Q. Those that you sold on the 11th of June, 1897. Before what date in what year were they imported?

A. They must have been imported in 1896. There is one exception, 1742."

But he has no personal knowledge on the subject by which he could so testify under oath.

He is asked on cross-examination:

"Q. Are you willing to swear of your own personal knowledge that those books were not brought into this country in 1897?

A. No, I will not swear."

This shows his testimony, that the books were imported in 1896, is merely hearsay.

All the testimony the witness gave was mere speculation, based on general konwledge. He would not swear to the time the books were brought into the country.

General conclusions of a witness, no matter how positively they may be stated, do not constitute affirmative proof of a fact.

The witness was a highly interested witness, the secretary and treasurer of defendant, and he would naturally state all conclusions as favorably as possible for the defendant.

It is respectfully submitted that the direction of a verdict for the defendant was erroneous and should have been reversed by the Circuit Court of Appeals.

A. BELL MALCOMSON,
Counsel for Appellant.

Addendum.

SECTION 4962, R. S., as amended by Act June 18, 1874, Forty-Third Congress, First Session, Chapter 301.

An act to amend the law relating to patents, trade-marks and copyrights.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, that no person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition *published*, on the title page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year , by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus: 'Copyright, 18 , by A. B."

Approved June 18, 1874.

SECTION 4963, R. S., IN 1896.

Statute before Amendment.

Section 4963, as amended by the Act of March 3, 1891, was as follows: "Every person who shall insert or impress such notice, or words of the same purport, in 'or upon any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States."

Amendment of 1897.

An Act to amend title sixty, chapter three, of the Revised Statutes of the United States, relating to copyrights.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That Section forty-nine hundred and sixty three of the Revised Statutes of the United State be, and the same is hereby, amended, so as to read as follows:

"*Sec. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph or other article*, whether such article be subject to copyright or otherwise, *for which he has not obtained a copyright*, or shall knowingly issue or sell any article bearing a notice of United States copyright which has not been copyrighted in this country; or shall import any book, photograph, chromo, or lithograph or other article bearing such notice of copyright or words of the same purport, which is not copyrighted in this country, *shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty and one half to the use of the United States;* and the importation into the United States of any book, chromo, lithograph, or photograph, or other article bearing such notice of copyright, when there is no existing copyright

thereon in the United States, is prohibited; and the Circuit Courts of the United States sitting in equity are hereby authorized to enjoin the issuing, publishing, or selling of any article marked or imported in violation of the United States copyright laws, at the suit of any person complaining of such violation: *Provided*, That this Act shall not apply to any *importation* of or *sale* of such goods or articles brought into the United States prior to the passage hereof."

SEC. 2. That all laws and parts of laws inconsistent with the foregoing provision be, and the same are hereby, repealed.

Approved, March 3, 1897.